

**REMARKS**

**Status of the Claims:**

Claims 1 – 7, 23 – 27 and 33 – 36 are currently pending.

Claims 8 – 22 and 28 – 32 are cancelled.

Claims 1 – 7 and 23 – 27 are currently rejected.

Claims 6 and 25 are currently objected to.

Claims 3 and 4 contain allowable subject matter if rewritten in independent form.

Claims 1 – 4, 6, 7 and 23 – 27 are currently amended.

Claims 33 – 36 are new claims

**Amendments to the Claims:**

No new matter has been introduced by way of the claim amendments.

*Independent Claims*

Independent claim 1 is presently amended to recite that at least one of X<sup>1</sup> and X<sup>2</sup> is not H. The limitation that not all of X<sup>1</sup>, X<sup>2</sup> and X<sup>3</sup> are H has also been rewritten for purposes of clarity to recite that at least one of X<sup>1</sup>, X<sup>2</sup> and X<sup>3</sup> is not H. Claim 1 is also amended to recite that Y<sup>1</sup> 'comprises' a polymerizable unit, rather than is a polymerizable unit. The limitations of original claim 2 have been incorporated as a limitation of the polymerizable unit of claim 1, namely that the polymerizable unit comprises a functional moiety selected from the group consisting of an epoxide, an alkene, an alkyne and combinations thereof. The definition of Y<sup>2</sup> has also been incorporated as a limitation of claim 1. The definition of Y<sup>2</sup> has been incorporated from original claim 7, with the exception that for alternative selection OR, R is selected from the group

consisting of alkyl, aryl and combinations thereof. The alternative selection that R is alkenyl in OR has been deleted.

Claim 3 has been rewritten in independent form to incorporate the limitations of claim 1 and the definition of Y<sup>2</sup> from original claim 7. Claim 3 also includes a limitation that at least one of X<sup>1</sup> and X<sup>2</sup> is not H. The limitation that not all of X<sup>1</sup>, X<sup>2</sup> and X<sup>3</sup> are H from original claim 1 has been rewritten for purposes of clarity to recite that at least one of X<sup>1</sup>, X<sup>2</sup> and X<sup>3</sup> is not H. In addition, claim 3 recites that Y<sup>1</sup> 'comprises' a polymerizable unit, rather than 'is' a polymerizable unit. The 'at least two polymerizing functional moieties' from original claim 3 have been amended to read 'at least two polymerizable functional moieties'.

Claim 23 is presently amended in element a) to recite that at least one of X<sup>1</sup> and X<sup>2</sup> is not H. The limitation that not all of X<sup>1</sup>, X<sup>2</sup> and X<sup>3</sup> are H has also been rewritten for purposes of clarity to recite that at least one of X<sup>1</sup>, X<sup>2</sup> and X<sup>3</sup> is not H. Claim 23 is also amended in element b) to delete the alternative R selection of alkenyl when at least one of Y<sup>2</sup> and Y<sup>9</sup>-Y<sup>12</sup> is selected to be OR. Claim 23 is amended in element d) to recite that at least one of Y<sup>1</sup> and Y<sup>5</sup>-Y<sup>8</sup> 'comprises' a polymerizable unit, rather than 'is' a polymerizable unit. Claim 23 also includes a further limitation in element d) that the polymerizable unit comprises a functional moiety selected from the group consisting of an epoxide, an alkene, an alkyne and combinations thereof. Support for this amendment may be found in at least paragraphs [0031] and [0038].

#### *Dependent Claims*

Claim 2 is presently amended to delete the alternative selections of the Markush group and to recite that the polymerizable unit comprises an alkene.

Claim 4 is presently amended to depend from claim 3, which has been rewritten into independent form. Further, claim 4 is amended to recite that the polymerizable unit 'comprises', rather than 'is' a bis-alkene.

Claim 6 is presently amended to include the structural formulas of polymerizable moieties 1 - 11.

Claim 7 is presently amended to delete the alternative selections of OR and R from the Markush group.

Claim 24 is presently amended in the preamble to recite a monomer, rather than a polymer. Claim 24 is also amended to recite that exactly one of  $Y^1$  and  $Y^5$ - $Y^8$  'comprises' a polymerizable unit, rather than 'is' a polymerizable unit.

Claim 25 is presently amended in the preamble to recite a monomer, rather than a polymer. The alternative selections for R under element (ii) have been amended to delete alkenyl from the Markush group. Claim 25 is also amended to delete elements (ix) and (x) from the claim.

Claim 26 is presently amended in the preamble to recite a monomer, rather than a polymer.

Claim 27 is presently amended in the preamble to recite a monomer, rather than a polymer. Claim 27 is also amended to depend from claim 23, rather than claim 22. Claim 27 is also amended in element (a) to delete references to  $X^1$ - $X^3$ , since those limitations are already included in base claim 23. Claim 27 is amended under element (vii) to delete alkenyl from the Markush group. Claim 27 is amended to delete element (ix). Claim 27 is amended in element (c) to recite that  $Y^1$  'comprises' a polymerizable unit, rather than 'is' a polymerizable unit.

#### *New Claims*

New claim 33 recites a further limitation of claim 24 that the polymerizable unit is selected from the Markush group of moieties **1 – 11**. Support for new claim 33 may be found in at least paragraphs [0011] and [0031].

New claim 34 recites a further limitation of claim 24. Support for new claim 34 may be found in at least original claim 25.

New claim 35 is an independent claim including the limitations of original claim 23 and further including the limitation in element d) that at least one of  $Y^1$  and  $Y^5$ - $Y^8$  is a polymerizable

unit selected from the Markush group of moieties **1 – 11**. New claim 35 also includes a limitation in element a) that at least one of  $X^1$  and  $X^2$  is not H. The limitation of original claim 23 that not all of  $X^1$ ,  $X^2$  and  $X^3$  are H has also been rewritten for purposes of clarity to recite that at least one of  $X^1$ ,  $X^2$  and  $X^3$  is not H. Support for new claim 35 may be found in at least original claim 23 and paragraphs [0011] and [0031].

New claim 36 recites a further limitation of the Markush group in element b) of new claim 35.

#### **I. Response to Restriction Requirement**

The Examiner has identified separate inventions in the application and has required restriction under 35 U.S.C. § 121 and 372. Office Action page 2, item 1. The claims are subject to restriction as follows:

**Group I: Claims 1 – 7 and 23 – 27 (drawn to monomers)**

**Group II: Claims 8 – 15, 17 – 22 and 28 – 32 (drawn to polymers)**

**Group III: Claim 16 (drawn to a method of making polymers)**

Applicants made a provisional election of Group I (claims 1 – 7 and 23 – 27) in a telephone conversation conducted on December 15, 2008. The provisional election was made without traverse. **Applicants confirm the election of Group I (claims 1 – 7 and 23 – 27) without traverse in the filing of this response.** Applicants hereby cancel claims 8 – 22 and 28 – 32, drawn to the non-elected groups, without prejudice or disclaimer. Applicants reserve rights to file one or more divisional applications on the subject matter of the non-elected groups at any time of Applicants' choosing during pendency of the instant application.

Applicants have included new claims 33 – 36 in the instant response. Applicants respectfully assert that the subject matter of new claims 33 – 36 is drawn to the invention of elected Group I.

## **II. Objection to the Specification**

The Examiner objects to the specification because the title is asserted not to be descriptive. The Examiner requires that a new title that is indicative of the invention to which the claims are directed. Office Action page 4, item 6.

The current title is "Flame Retardant Polymers". The Examiner suggests the title "Flame Retardant Addition and Metathesis Polymers Derived from Bisphenol-C". Office Action page 4, item 7.

Applicants respectfully request that the title be amended to read "Flame Retardant Polymers Having Pendant Groups Related to Bisphenol-C and Monomers for Synthesis Thereof". Applicants respectfully assert that the title is descriptive of the claimed invention.

## **III. Claim Objections**

### *III.1 Objection to Claim 6*

The Examiner objects to claim 6 because polymerizable moieties 1 – 11 should be reproduced in the claim. Office Action page 4, item 8.

Applicants have amended claim 6 to include structural formulas for polymerizable moieties 1 - 11 in the claim. Therefore, Applicants respectfully request that the Examiner's objection to claim 6 be withdrawn.

### *III.2 Objection to Claim 25*

The Examiner objects to claim 25 because of non-sequential numbering of the selections for Y functional groups within the claim. Office Action page 4, item 9.

Applicants have amended claim 25 and deleted that portion of the claim that includes non-sequential Roman numbering. Hence, the Examiner's objection is rendered moot. Therefore, Applicants respectfully request that the Examiner's objection to claim 25 be withdrawn.

**IV. Claims Rejections Made Under 35 U.S.C. § 112**

*IV.1 Claims 1 – 6 and 24 – 27 Asserted as Indefinite Under 35 U.S.C. § 112, Second Paragraph*

Claims 1 – 6 and 24 – 27 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Office Action page 5, item 12.

The Examiner asserts that claims 1 – 6 do not include a definition of the functional group Y<sup>2</sup> on either of formulas I or II. The Examiner asserts that such omission renders the claim indefinite. Office Action page 5, item 13. The Examiner states that for examination purposes, the functional group Y<sup>2</sup> has been treated as defined in instant claim 7.

Applicants have amended claim 1 to recite that Y<sup>2</sup> is selected from the group consisting of OH; H; Cl; Br; I; F; OR, wherein R is selected from the group consisting of alkyl, aryl, and combinations thereof; and R, wherein R is selected from the group consisting of alkyl, alkenyl, alkynyl, and combinations thereof. Therefore, Applicants respectfully assert that claims 1 – 6, as amended, are not indefinite. Applicants respectfully request that the Examiner's rejection of claims 1 – 6 under 35 U.S.C. § 112, second paragraph, be withdrawn.

*IV.2 Claims 24 – 27 Asserted as Indefinite Under 35 U.S.C. § 112, Second Paragraph*

The Examiner asserts that claims 24 – 27 recite the limitation of the polymer of the respective parent claims. Since parent claim 23 is drawn to a monomer and not a polymer, the Examiner alleges that the claims are indefinite. Further, claim 27 refers to parent claim 22, drawn to a method and not a monomer, which the Examiner also cites as indefinite. Office Action page 5, item 14. The Examiner states that for examination purposes, claims 24 – 27 have been treated as referring to monomers and claim 27 has been treated as referring to parent claim 23.

Applicants have amended claims 24 – 27 in their respective preambles to properly refer to a monomer instead of a polymer. Further, Applicants have amended claim 27 to depend from claim 23 instead of from claim 22. Therefore, Applicants respectfully assert that claims 24 – 27, as amended, are not indefinite. Applicants respectfully request that the Examiner's rejection of claims 24 – 27 under 35 U.S.C. § 112, second paragraph, be withdrawn.

**V. Claim Rejections Under 35 U.S.C. § 102**

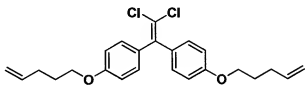
*V.1. Standard of Review*

The standard of review for establishing anticipation under 35 U.S.C. § 102 is set forth as follows: "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP § 2131.

*V.2. Rejection of Claims 1, 2, 5 – 7, 23 – 25 and 27 Under 35 U.S.C. § 102(a)*

Claims 1, 2, 5 – 7, 23 – 25 and 27 stand rejected under 35 U.S.C. § 102(a) as being anticipated by Jurs, *et al.*, *Polymer*, 44:2003, pp. 3709 – 3714 (hereinafter, *Jurs*). Office Action page 5, item 16. Applicants respectfully traverse the Examiner's rejection of these claims.

The Examiner alleges that *Jurs* teaches the following compound (Office Action page 6, item 17):



*V.2.1 Rejection of Claims 1, 2 and 5 – 7 as Anticipated by Jurs*

Regarding claims 1, 2, 5 and 7, the Examiner alleges that the claims are anticipated by the above compound of *Jurs* for the following reasons. The compound taught by *Jurs* has X<sup>1</sup> and

X<sup>2</sup> as Cl, the group Y<sup>1</sup> as an alkenyl group (a polymerizable unit) attached to the phenyl ring via three methylene spacer units, and the group Y<sup>2</sup> as OR in which R is an alkenyl group. Office Action page 6, item 18. Regarding claim 6, the Examiner alleges that the polymerizable unit of Y<sup>1</sup> is the same as moiety 2 (a vinyl group). Office Action page 6, item 19.

Applicants respectfully assert that independent claim 1, as amended, is not anticipated by the compound of *Jurs*. In particular, claim 1, as amended, now includes limitations that 1) Y<sup>1</sup> comprises a polymerizable unit which comprises a functional moiety selected from the group consisting of an epoxide, an alkene, an alkyne and combinations thereof, and 2) Y<sup>2</sup> is selected from the group consisting of OH, H, Cl, Br, I, F, OR (R is selected from the group consisting of alkyl, aryl and combinations thereof), and R (R is selected from the group consisting of alkyl, alkenyl, alkynyl and combinations thereof). Applicants have deleted 'alkenyl' from the Markush group reciting the alternative selections for R in OR, from which Y<sup>2</sup> can be selected.

*Jurs* explicitly teaches a compound in which the polymerizable moiety Y<sup>1</sup> is an alkenyl group and Y<sup>2</sup> is OR, wherein R is alkenyl. Since claim 1, as amended, does not recite that Y<sup>2</sup> can be OR, wherein R is an alkenyl group, Applicants respectfully assert that claim 1 is not anticipated by *Jurs*. Claims 2 – 7 depend either directly or indirectly from claim 1 and are not anticipated by *Jurs* for at least the same reasons. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). In view of the foregoing, Applicants respectfully request that the Examiner's rejection of claims 1, 2 and 5 – 7 as anticipated by *Jurs* under 35 U.S.C. § 102(a) be withdrawn.

#### *V.2.2 Rejection of Claims 23 – 25 and 27 as Anticipated by Jurs*

Regarding claims 23 – 25 and 27, the Examiner alleges that the claims are anticipated by the above compound of *Jurs* for the following reasons. The compound taught by *Jurs* has X<sup>1</sup> and X<sup>2</sup> as Cl, the group Y<sup>2</sup> as OR in which R is an alkenyl group, the groups Y<sup>9</sup> – Y<sup>12</sup> as H, the group Y<sup>1</sup> as an alkenyl group (a polymerizable unit), and the groups Y<sup>5</sup> – Y<sup>8</sup> as H. Office Action page 6, item 20.



Applicants respectfully assert that independent claim 23, as amended, is not anticipated by the compound of *Jurs*. In particular, claim 23, as amended, now includes limitations that 1) at least one of Y<sup>1</sup> and Y<sup>5</sup>-Y<sup>8</sup> comprises a polymerizable unit which comprises a functional moiety selected from the group consisting of an epoxide, an alkene, an alkyne and combinations thereof, and 2) at least one of Y<sup>2</sup> and Y<sup>9</sup>-Y<sup>12</sup> is selected from the group consisting of OH, H, Cl, Br, I, F, OR (R is selected from the group consisting of alkyl, aryl and combinations thereof), and R (R is selected from the group consisting of alkyl, alkenyl, alkynyl and combinations thereof). Applicants have deleted 'alkenyl' from the Markush group reciting the alternative selections for R in OR, from which at least one of Y<sup>2</sup> and Y<sup>9</sup>-Y<sup>12</sup> can be selected.

*Jurs* explicitly teaches a compound in which the polymerizable moiety Y<sup>1</sup> is an alkenyl group, Y<sup>5</sup>-Y<sup>12</sup> are H, and Y<sup>2</sup> is OR, wherein R is alkenyl. Since claim 23, as amended, does not recite that Y<sup>2</sup> can be OR, wherein R is an alkenyl group, Applicants respectfully assert that claim 23 is not anticipated by *Jurs*. Claims 24 – 27 depend either directly or indirectly from claim 23 and are not anticipated by *Jurs* for at least the same reasons. Furthermore, new claims 33 and 34 merely recite further limitations of claim 23 and are also not anticipated by *Jurs* for at least the same reasons. In view of the foregoing, Applicants respectfully request that the Examiner's rejection of claims 23 – 25 and 27 as anticipated by *Jurs* under 35 U.S.C. § 102(a) be withdrawn.

#### *V.2.3 New Claims 35 and 36 Are Not Anticipated by Jurs*

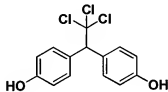
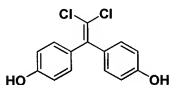
Applicants respectfully assert that new claims 35 and 36 are also not anticipated by *Jurs*. In particular, claim 35 recites in element d) that at least one of Y<sup>1</sup> and Y<sup>5</sup>-Y<sup>8</sup> is a polymerizable unit selected from the group consisting of moieties **1 – 11**. Applicants respectfully assert that by reciting that at least one of Y<sup>1</sup> and Y<sup>5</sup>-Y<sup>8</sup> is a polymerizable unit, the claim should properly be interpreted to read that at least one of Y<sup>1</sup> and Y<sup>5</sup>-Y<sup>8</sup> are selected from moieties **1 – 11** that are directly attached to the phenyl ring, as indicated in formulas I and II. In contrast, by reciting that at least one of Y<sup>1</sup> and Y<sup>5</sup>-Y<sup>8</sup> comprises a polymerizable unit, such as in instant claim 23, Y<sup>1</sup> and Y<sup>5</sup>-Y<sup>8</sup> are opened to the inclusion of other elements such as, for example, a spacer group and additional functionality.

*Jurs* explicitly teaches a compound in which the polymerizable moiety  $Y^1$  is an alkenyl group,  $Y^5$ - $Y^{12}$  are H, and  $Y^2$  is OR, wherein R is alkenyl. However, *Jurs* does not teach a polymerizable unit  $Y^1$  that is directly attached to the phenyl ring and is selected from moieties 1 – 11. Hence, new claim 35 is not anticipated by *Jurs*. New claim 36 depends from new claim 35 and is allowable for at least the same reasons.

V.3. Rejection of Claims 1, 7, 23 – 25 and 27 Under 35 U.S.C. § 102(b)

Claims 1, 7, 23 – 25 and 27 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Factor, *et al.*, *J. Polymer Sci.*, 18:2003, pp. 579 – 592 (hereinafter, *Factor*). Office Action page 6, item 21. Applicants respectfully traverse the Examiner's rejection of these claims.

The Examiner alleges that *Factor* teaches the following compounds (Office Action page 7, item 22):



V.3.1 Rejection of Claims 1 and 7 as Anticipated by Factor

Regarding claims 1 and 7, the Examiner alleges that the claims are anticipated by the above compounds of *Factor* for the following reasons. The compounds taught by *Factor* have  $X^1$ ,  $X^2$  and  $X^3$  as Cl, the group  $Y^1$  as OH (a polymerizable unit), and the group  $Y^2$  as OH. Office Action page 7, item 23.

Applicants respectfully assert that independent claim 1, as amended, is not anticipated by the compounds of *Factor*. In particular, claim 1, as amended, now includes a limitation that  $Y^1$  comprises a polymerizable unit which comprises a functional moiety selected from the group consisting of an epoxide, an alkene, an alkyne and combinations thereof.

*Factor* explicitly teaches compounds in which  $Y^1$  is an OH group. Applicants respectfully assert that claim 1, as amended, cannot be anticipated by *Factor*, since  $Y^1$  cannot simultaneously be an OH group, while comprising a functional moiety selected from the group consisting of an epoxide, an alkene, an alkyne, and combinations thereof, as is now required by claim 1. To include any of these functional moieties, the H of the OH group in *Factor* would have to be removed to link the functional moieties to O. Such compounds are not taught by *Factor*. Claims 2 – 7 depend either directly or indirectly from claim 1 and are not anticipated by *Factor* for at least the same reasons. In view of the foregoing, Applicants respectfully request that the Examiner's rejection of claims 1 and 7 as anticipated by *Factor* under 35 U.S.C. § 102(b) be withdrawn.

*V.3.2 Rejection of Claims 23 – 25 and 27 as Anticipated by Factor*

Regarding claims 23 – 25 and 27, the Examiner alleges that the claims are anticipated by the above compounds of *Factor* for the following reasons. The compounds taught by *Factor* have  $X^1$ ,  $X^2$  and  $X^3$  as Cl, the group  $Y^1$  as OH (a polymerizable unit), the groups  $Y^5$ - $Y^8$  as H, the group  $Y^2$  as OH, and the groups  $Y^9$ - $Y^{12}$  as H. Office Action page 7, item 24.

Applicants respectfully assert that independent claim 23, as amended, is not anticipated by the compounds of *Factor*. In particular, claim 23, as amended, now includes a limitation that at least one of  $Y^1$  and  $Y^5$ - $Y^8$  comprises a polymerizable unit which comprises a functional moiety selected from the group consisting of an epoxide, an alkene, an alkyne and combinations thereof.

*Factor* explicitly teaches compounds in which  $Y^1$  is an OH group. Applicants respectfully assert that claim 23, as amended, cannot be anticipated by *Factor*, since  $Y^1$  cannot simultaneously be an OH group, while comprising a functional moiety selected from the group consisting of an epoxide, an alkene, an alkyne, and combinations thereof, as is required by claim 23. To include any of these functional moieties, the H of the OH group in *Factor* would have to be removed to link the functional moieties to O. Such compounds are not taught by *Factor*. Claims 24 – 27 depend either directly or indirectly from claim 23 and are not anticipated by

*Factor* for at least the same reasons. Furthermore, new claims 33 and 34 merely recite further limitations of claim 23 and are also not anticipated by *Factor* for at least the same reasons. In view of the foregoing, Applicants respectfully request that the Examiner's rejection of claims 23 – 25 and 27 as anticipated by *Factor* under 35 U.S.C. § 102(b) be withdrawn.

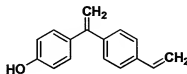
*V.3.3 New Claims 35 and 36 Are Not Anticipated by Factor*

Applicants respectfully assert that new claims 35 and 36 are also not anticipated by *Factor*. In particular, claim 35 recites in element d) that at least one of  $Y^1$  and  $Y^5$ - $Y^8$  is a polymerizable unit selected from the group consisting of moieties 1 – 11. *Factor* explicitly teaches compounds in which  $Y^1$  is an OH group, which is not one of moieties 1 – 11. Hence, new claim 35 is not anticipated by *Factor*. New claim 36 depends from new claim 35 and is allowable for at least the same reasons.

*V.4. Rejection of Claims 1, 2, 6, 7, 23, 24, 26 and 27 Under 35 U.S.C. § 102(b)*

Claims 1, 2, 6, 7, 23, 24, 26 and 27 stand rejected under 35 U.S.C. § 102(b) as being anticipated by United States Patent 4,982,007 (hereinafter, '007). Office Action page 7, item 25. Applicants respectfully traverse the Examiner's rejection of these claims.

The Examiner alleges that '007 teaches the following compound (Office Action page 7, item 26):



*V.4.1 Rejection of Claims 1, 2, 6 and 7 as Anticipated by '007*

Regarding claims 1, 2, and 7, the Examiner alleges that the claims are anticipated by the above compound of '007 for the following reasons. The compound taught by '007 has  $X^1$  and  $X^2$  as H, the group  $Y^1$  as a polymerizable unit (an alkene), and the groups  $Y^2$  and  $Y^5$ - $Y^{12}$  as H.

Office Action page 8, item 27. Regarding claim 6, the Examiner alleges the '007 teaches a polymerizable unit  $Y^1$  which is functional moiety **2** (a vinyl group). Office Action page 8, item 28. The Examiner notes that the rejection may be overcome by adding a limitation that not both of  $X^1$  and  $X^2$  may be H. Office Action page 9, item 30.

Applicants have included the amendment suggested by the Examiner. Applicants respectfully assert that independent claim 1, as amended, is not anticipated by the compound of '007. In particular, claim 1, as amended, now includes a limitation that at least one of  $X^1$  and  $X^2$  is not H and a limitation that at least one of  $X^1$ ,  $X^2$  and  $X^3$  is not H.

'007 explicitly teaches a compound having both  $X^1$  and  $X^2$  as H. Applicants respectfully assert that claim 1, as amended, is not anticipated by '007, since claim 1 now requires that at least one of  $X^1$  and  $X^2$  is not H. Claims 2 – 7 depend either directly or indirectly from claim 1 and are not anticipated by '007 for at least the same reasons. In view of the foregoing, Applicants respectfully request that the Examiner's rejection of claims 1, 2, 6 and 7 as anticipated by '007 under 35 U.S.C. § 102(b) be withdrawn.

*V.4.2 Rejection of Claims 23, 24, 26 and 27 as Anticipated by '007*

Regarding claims 23, 24, 26 and 27, the Examiner alleges that the claims are anticipated by the above compound of '007 for the following reasons. The compound taught by '007 has  $X^1$  and  $X^2$  as H, the group  $Y^1$  as a polymerizable unit (an alkene), and the groups  $Y^2$  and  $Y^5-Y^{12}$  as H. Office Action page 9, item 29. The Examiner notes that the rejection may be overcome by adding a limitation that not both of  $X^1$  and  $X^2$  may be H. Office Action page 9, item 30.

Applicants have included the amendment suggested by the Examiner. Applicants respectfully assert that independent claim 23, as amended, is not anticipated by the compound of '007. In particular, claim 23, as amended, now includes a limitation that at least one of  $X^1$  and  $X^2$  is not H and a limitation that at least one of  $X^1$ ,  $X^2$  and  $X^3$  is not H.

'007 explicitly teaches a compound having both  $X^1$  and  $X^2$  as H. Applicants respectfully assert that claim 23, as amended, is not anticipated by '007, since claim 23 now requires that at

least one of  $X^1$  and  $X^2$  is not H. Claims 24 – 27 depend either directly or indirectly from claim 23 and are not anticipated by '007 for at least the same reasons. Furthermore, new claims 33 and 34 merely recite further limitations of claim 23 and are also not anticipated by '007 for at least the same reasons. In view of the foregoing, Applicants respectfully request that the Examiner's rejection of claims 23, 24, 26 and 27 as anticipated by '007 under 35 U.S.C. § 102(b) be withdrawn.

*V.4.3 New Claims 35 and 36 Are Not Anticipated by '007*

Applicants respectfully assert that new claims 35 and 36 are also not anticipated by '007. In particular, claim 35 recites limitations in element a) that at least one of  $X^1$  and  $X^2$  is not H and at least one of  $X^1$ ,  $X^2$  and  $X^3$  is not H. '007, in contrast, explicitly teaches a compound in which both  $X^1$  and  $X^2$  are H. Hence, new claim 35 is not anticipated by '007. New claim 36 depends from new claim 35 and is allowable for at least the same reasons.

**VI. Allowable Subject Matter**

The Examiner has stated that claims 3 and 4 would be allowable if written to overcome their rejection under 35 U.S.C. § 112, second paragraph, and including all limitations of the base claims and intervening claims. Office Action page 8, item 31.

Applicants have rewritten claim 3 into independent form, incorporating all of the limitations of base claim 1 and claim 7 for the definition of  $Y^2$ . Applicants have also added the limitations that at least one of  $X^1$  and  $X^2$  is not H and at least one of  $X^1$ ,  $X^2$  and  $X^3$  is not H. Furthermore, claim 4 has been amended to depend from claim 3. Hence, Applicants respectfully assert that claims 3 and 4 are now allowable.

Applicants have amended claims 3 and 4 to be rewritten in allowable form and not to overcome the cited references. Hence, no prosecution history estoppel arises from the amendments to claims 3 and 4. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 62 U.S.P.Q.2d 1705, 1711-12 (2002); 56 U.S.P.Q.2d 1865, 1870 (Fed. Cir. 2000). Further, the amendments made to claims 3 and 4 were not made for a substantial reason related to

patentability. Therefore, no prosecution history estoppel arises from such amendments. *See Festo Corp.*, 62 U.S.P.Q.2d 1705 at 1707 (2002); *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 41 U.S.P.Q.2d 1865, 1873 (1997).

### **CONCLUSIONS**

Claims 1 – 7, 23 – 27, and 33 – 36 remain pending in the application. Applicants respectfully submit that claims 1 – 7, 23 – 27 and 33 – 36, as these claims presently stand amended, are in a condition for allowance based on the remarks presented hereinabove.

If additional fees are due and are not included, the Director is hereby authorized to charge any fees or credit any overpayment to Deposit Account Number 23-2426 of Winstead PC (referencing matter 11321-P067WOUS).

If the Examiner has any questions or comments concerning this paper or the present application in general, the Examiner is invited to call the undersigned at 713-650-2782.

Respectfully submitted,

WINSTEAD PC

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Date: May 4, 2009

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